

REMARKS

Claims 32-41 and 54-63 have been cancelled. Claims 64 - 77 are new. The new claims find support at pages 6, 12, and 13 of the specification. The following rejections were at issue with respect to the cancelled claims. Inasmuch as the rejections are pertinent to the new they claims they are briefly addressed below and are set forth by number:

1. Claims 32-35, 39 and 40 are rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking an adequate written description;
2. Claims 32, 33, 35, 36, 39 and 40 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Zernicka-Goetz et al;
3. Claims 32, 33 and 35-40 are rejected under 35 U.S.C. §103(a) as allegedly being obvious over Zernicka-Goetz et al. in view of Ikawa et al. and in further view of Wobus et al., Sartorelli et al., and Chen et al. and Claims 32-40 are rejected under 35 U.S.C. §103(a) as allegedly being obvious over Zernicka-Goetz et al., Ikawa et al., Wobus et al., Sartorelli et al., and Chen et al. in view of Maltsev and Rohwedel.

1. The claims are supported by an adequate written description

Previously pending claims 32-35, 39 and 40 were rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking an adequate written description. The Examiner alleges Applicant did not point to the specification for support for the claim limitation that the promoter is “substantially inactive in undifferentiated embryonic stem cells.” For the reasons noted in applicants previous response, applicants believe this rejection is unfounded and do not acquiesce to the Examiners current arguments with respect to the cancelled claims. Nevertheless, the new claims specify that the promoter is activated after differentiation of the stem cells. Support for this limitation is found, among other places, in the specification at page six where it is taught that the cells can be observed while differentiating and that ES cells expressing the fluorescent protein become visible upon activation of the specific promoter during differentiation.

2. The claims are novel

Previously pending claims 32, 33, 35, 36, 39 and 40 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Zernicka-Goetz et al. Applicants respectfully submit that the new claims are not anticipated because they specify steps for using ES cells in a method of assaying test compounds. Zernicka-Goetz et al. does not teach or suggest such an assay method.

3. The claims are not obvious

Previously pending claims 32, 33 and 35-40 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Zernicka-Goetz et al. in view of Ikawa et al. and in further view of Wobus et al., Sartorelli et al., and Chen et al. and Claims 32-40 are rejected under 35 U.S.C. §103(a) as allegedly being obvious over Zernicka-Goetz et al., Ikawa et al., Wobus et al., Sartorelli et al., and Chen et al. in view of Maltsev and Rohwedel.

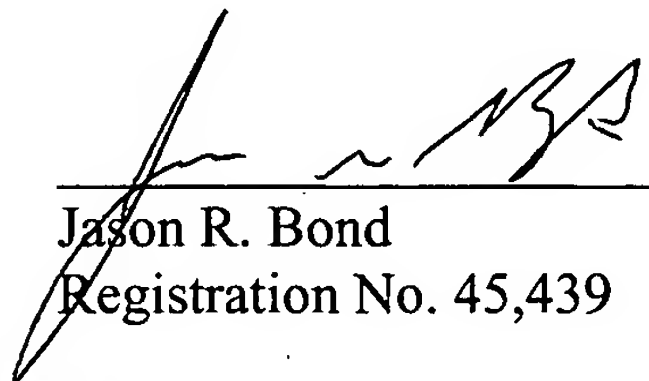
A *prima facie* case of obviousness requires the Examiner to provide a reference(s) which (a) discloses all of the elements of the claimed invention, (b) suggests or motivates one skilled in the art to combine the claimed elements to produce the claimed combination, and (c) provides a reasonable expectation of success should the claimed combination be carried out. Failure to establish any one of these three requirements precludes a finding of a *prima facie* case of obviousness and without more entitles the Applicants to allowance of the claims in issue. *See, e.g., Northern Telecom Inc. v. Datapoint Corp.*, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990). In addressing this rejection, Applicants focus on the independent claims since the non-obviousness of independent claims necessarily leads to the non-obviousness of claims dependent thereon.¹ As argued above, the cited references cannot be used establish a *prima facie* case of obviousness because none of the references teach or suggest steps for using ES cells in a method of assaying test compounds. Thus, all of the elements of the claims are not disclosed.

¹ §MPEP 2143.03.

CONCLUSION

It is respectfully submitted that the invention as claimed fully meets all requirements and that the claims are worthy of allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicant encourages the Examiner to call the undersigned collect at (608) 218-6900.

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